

Remarks:

Applicants have studied the Office Action dated November 9, 2007, and has amended the claims to distinctively claim the subject matter of the invention. Support for the claims is found within the specification and the drawings. It is submitted that the application is in condition for allowance. Reconsideration and reexamination are respectfully requested.

Allowable Subject Matter:

The Applicants wish to thank the Examiner for finding claims 35 to 42 allowable.

In the following, the Applicants respond to the Examiner's rejection under Section 112 and objections as to introduction of new matter.

§112 Rejection(s):

The Examiner rejects the pending claims as failing to comply with written description and enablement requirements, under 112 par. 1 and as being indefinite under 112 par. 2. The rejection is respectfully traversed.

The Examiner is reminded that the claim language should be interpreted in light of the specification and common knowledge (i.e., "common sense") available to person of ordinary skill, otherwise the application would be an endless construction of common details which are not necessary for the full understanding of the invention (see MPEP 2173.05).

Common sense would allow a person of ordinary skill reading the application as filed to determine that a toy, in general, has a body with body parts. The Examiner would agree that this is nothing out of the ordinary. In fact, to contend otherwise, would result in the extra-ordinary as one would not expect a toy not to have a body or a body part, unless the toy is a virtual toy.

The Examiner contends that he deems the invention to be related to a virtual toy. However, there is no reason for the Examiner to interject such limitation into the claims. There is no portion in the specification that either explicitly or implicitly limits the invention to a virtual toy (i.e., a toy displayed on a screen).

Referring to the figures and the specification, it is clear that the invention can be directed to a physical toy, (i.e., a learning and growing toy mentioned on page 6 of the specification as filed) that can be *connected* to a computer, and not necessarily a virtual toy that appears on a computer screen. Respectfully, referring to pages 9, 12 and 15 specifically, and in light of the specification in its entirety, in several instances the specification supports the notion that the toy may grow both intellectually and physically. Again, no portion of the specification has an express limitation that the physical growth is not to apply to the physical limbs of the toy, nor is there any support for the Examiner's contention that the growth is virtual in nature.

Respectfully, one of ordinary skill would understand that a toy can physically grow in size by way of a mechanical instrument incorporated in one of the toy's physical limbs, elements or attributes. Particularly, referring to FIG. 5, a motor 100-1 is disclosed which supports a mechanical instrument within the toy that may be used to move or grow a limb. As such, the Examiner's argument that the egg-shaped drawing in FIG. 11 should be interpreted narrowly to exclude any physical growth in the toy, and to limit it to a virtual character on a screen, is counter intuitive to the nature and spirit of the disclosure, particularly in light of the fact that (1) the specification never refers to virtual growth per se and (2) the specification refers in multiple section to "physical" growth of the toy.

For the above reasons, the simplified depiction in FIG. 11 is not adequate support for the Examiner's argument that the "physical" growth disclosed in the specification is virtual in nature. Respectfully, such over simplification is inappropriate and insufficient grounds for rejection under 112.

The Examiner is reminded that §112, first paragraph, requires for the specification to adequately support the subject matter claimed rather than mirroring the claim language word for word. MPEP 2163, Moba, B.V. v. Diamond Automation, Inc., 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); Vas-Cath, Inc. v. Mahurkar, 935 F.2d at 1563, 19 USPQ2d at 1116.

Furthermore, support can be provided “in a variety of ways” and “using such descriptive means as words, structures, figures, diagrams, and formulas” to “show that the Applicants were in possession of the claimed invention. Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). See, e.g., Pfaff v. Wells Elecs., Inc., 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998) (emphasis added). Claim limitations may be supported in the specification through “express, implicit, or inherent disclosure.” See In re Oda, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971).

Accordingly, contrary to the Examiner’s position, the test under Section 112 is not whether all possible details are included in the specification or the claim, but whether a person of ordinary skill would understand, based on common sense or common knowledge, how the invention works, if he read the specification.

Over the past decades, there have been many examples of toys with moving and growing limbs and parts, or toys that imitate emotion and desire available in the market. As an example of toys that display desire or imitate emotion, talking dolls, or barking plush toys are common in any toy store. As an example of toys that grow in size, any toy with a telescopic arm or leg or other body part would suffice. As such, the Examiner is respectfully requested to reconsider and withdraw the 112 grounds of rejection.

The Examiner also contends that claim language related to a living organism’s emotions and desires is vague. The Applicants respectfully submit that a person of ordinary skill would understand that information associated with emotions of a living organism comprise information about whether the living organism is happy, sad, hungry, excited, friendly, hostile, etc. The claim language should be interpreted in light of the specification and common knowledge (i.e., “common sense”) available to a person of ordinary skill; otherwise, the Application would be an endless construction of common details which are not necessary for the full understanding of the invention (see MPEP 2173.05).

For the above reasons, the Examiner is requested to withdraw the 112 rejection or otherwise recite case law or a statute in support of his rejections, particularly the latter rejection

pertaining to the allegation of claim language being vague simply because the claim languages recites emotions and desires that may vary per subject or in time. There is no support in the MPEP for rejecting claim language as vague, just because the claim language covers a variety of possibilities.

It would be improper for the Examiner to continue rejecting the claims as vague when no case law or statutory example is provided to support the Examiner's position; particularly where the claim language as read and understood by a person of ordinary skill in the art, it not vague but supports different possibilities. Respectfully, the fact that claim language covers multiple or a variety of possibilities does not render it vague. To the contrary, the use of broad and encompassing language is deemed appropriate so long as it is supported by the specification.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (213) 623 2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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